

It was further stated that currently no claim is generic. Accordingly, the invention was restricted to the above-identified patentably distinct species.

In Applicants' previous response, elected, with traverse, to prosecute Species I (Figure 4), which Applicants believed corresponded to Claims 1-22. However, the Examiner has alleged that the "majority of the claims 1-22 do not read on Figure 4." In particular, the Examiner alleges that "Claims 1, 6 read of Figure 4 and claims 2-5 and 7-22 do not read on Figure 4." Applicants respectfully disagree, and again traverse the restriction requirement and request the Examiner withdraw the restriction.

However, in order to comply with the requirements of 37 C.F.R. § 1.143, Applicants provisionally elect with traverse Species VI, which the Examiner stated corresponds to Claims 15-22, and withdraw claims 1-14 and 23-69. Applicants reserves the right to request rejoinder under MPEP 821.04 or otherwise reinstate the withdrawn claims, if appropriate, and/or to prosecute any future cancelled claims in one or more subsequent divisional applications, without prejudice

Applicants respectfully submit that this election should not be interpreted or construed as a limitation on the breadth and scope of elected and non-elected claims, but is merely a sufficient response to the restriction requirement.

#### Improper Species Restriction

The Examiner has required an 8- way restriction (species I to VIII) based on Figures 4-11. In addition the Examiner required that Applicants identify the claims that read on each alleged species in the original restriction requirement. In the most recent Office Action, the Examiner identified some claims, but not all claims, and their respective species designations. The Examiner did not provide any reasons or support for the holding that the alleged 8 species are distinct.

Applicants respectfully request the Examiner (i) identify the claims associated with each alleged species, (ii) provide the Examiner's reasons for believing the 8 species to be distinct , and (iii) set forth a *prima facie* case as to the serious burden on the Examiner if restriction is not required.

### Identification of Claims

Applicants request identification of the claims associated with each alleged species for purposes of clarity and future prosecution. In particular, MPEP § 814 states that the “examiner must provide a clear and detailed record of the restriction requirement to provide a clear demarcation between restricted inventions so that it can be determined whether inventions claimed in a continuing application are consonant with the restriction requirement. “ (Emphasis in original.)

In the instant case, Applicants do not understand the Examiner’s restriction requirement, and therefore cannot properly pursue divisional or continuation applications based on the restriction. Based on the most recent Office Action, the Examiner clearly has associated certain of the claims with certain species. Applicants request that the Examiner share that analysis so that Applicants may file proper continuing cases based on the non-elected claims.

### Reasons for Species Restriction

The request for reasons as to why the Examiner believes the 8 species are distinct is based on provisions in the MPEP. MPEP § 808.01 states:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

In the present application, the Examiner has only made a simple conclusory statement that: “The species are independent or distinct because they are directed towards different invention [sic].” This is exactly the type of “mere statement of conclusion” that the MPEP regards as inadequate.

MPEP § 814 only buttresses this requirement by stating (with respect to a species restriction):

The particular limitations in the claims and the reasons why such limitations are considered to support restriction of the claims to a particular disclosed species should be mentioned to make the requirement clear.

Therefore, Applicants respectfully request the particular reasons relied upon by the Examiner in making the restriction requirement.

### Serious Burden

Every restriction requirement has two basic criteria, both of which must be met for a proper requirement. As set forth in MPEP § 803:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent . . . or distinct as claimed . . . ;  
and
- (B) There would be a serious burden on the examiner if restriction is not required . . .

(Citations omitted.) Applicants submit that the Examiner has not made any showing as to the second requirement, namely that there would be a serious burden on the examiner if restriction is not required.

MPEP § 808.02 sets forth the requirements for establishing this burden:

Where the related inventions as claimed are shown to be independent or distinct . . . the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

(A) **Separate classification thereof:** This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different

search queries), a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.

Therefore, even assuming *arguendo*, that the Examiner can show that the inventions are distinct or independent, the Examiner must additionally show there is a serious burden on the Examiner, if the claims are not restricted. In the present case, the Examiner has merely made conclusory statements that the inventions require different field of search and have acquired separate status in the art without providing any justification. MPEP § 803 states: "For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification or separate status in the art, or a different field of search as defined in MPEP § 808.02." Applicants submit that the Examiner has not even made out such a *prima facie* showing. Therefore, Applicants respectfully request evidence of a serious burden or withdrawal of the requirement.

#### Contradictory Species Restriction

Applicants submit that the Examiner has contradicted her own species restriction. In the most recent Office Action, the Examiner states: "Claim 15 is directed towards the limitations that are described in Figures 5 and 9 [i.e., the Species II and Species VI.]" Thus, the Examiner appears to state that Claim 15 corresponds to both Species II and Species VI. This is clearly contradictory and erroneous.

By its definition, it is impossible for two species to be independent and distinct if one claim (i.e., Claim 15) corresponds to both species. Thus, either Claim 15 must be a generic claim (at least with regards to Species II and Species VI) or the restriction must be improper. As noted above, the Examiner has stated that no claim is currently generic, and therefore Applicants submit that the restriction is improper.

### Generic Claims

The Examiner stated that “[c]urrently no claims are generic.” Based on the Examiner’s own admissions, this is clearly untrue and erroneous. As noted above, the Examiner has alleged that Claim 15 corresponds to both Species II and Species VI, and thus by the Examiner’s own admission, Claim 15 must be generic to at least Species II and Species VI.

Similarly, the Examiner noted that independent Claim 1 corresponds to Figure 4, which was designated Species I. The Examiner then states that Claims 2-5 and 7-11 correspond to Figure 7, designated Species IV, that Claims 12-13 correspond to Figure 8, designated Species V, and that Claim 14 corresponds to Figure 5, designated Species II. Since Claims 2-5, 7-11, 12-13, and 14 are dependent claims that depend from Claim 1, Claim 1 must be generic at least to those claims. See MPEP § 806.04(d) defining a Generic Claim. Thus, again by the Examiner’s own admissions, Claim 1 must be generic at least with respect to Species I, IV, V, and II.

Therefore, Applicants respectfully request clarification as to the existence of any generic claims.

### Conclusion

For the reasons set forth above, Applicants believe the restriction requirement is improper, and should be withdrawn. Therefore, Applicants respectfully request the restriction be withdrawn and all claims allowed. In the alternative, if the requirement is not withdrawn, Applicants respectfully request the Examiner make the requirement final so that Applicants may file a petition with the Director to review the requirement.

The Commissioner is hereby authorized to charge any fees which may be required or credit any overpayment to deposit account 24-0040.

Should the Examiner have any further comments and suggestions, it respectfully requested that the Examiner telephone the undersigned in order to expeditiously resolve any outstanding issues.


Respectfully submitted,



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*I hereby certify that this correspondence is being deposited with the United States Postal Service as **first class mail** in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on October 20, 2006.*

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Signature